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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/287,631	04/07/1999	JOHN M. EBY	03063.0396-0	6525

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FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER LLP
1300 I STREET, NW
WASHINGTON, DC 20005

EXAMINER
KUHNS, ALLAN R

ART UNIT	PAPER NUMBER
1732	44

DATE MAILED: 06/20/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/287,631	Applicant(s) EBY ET AL.
	Examiner KUHNS	Group Art Unit 1732

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

P riod for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE THREE(3) MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

☒ Responsive to communication(s) filed on APRIL 10, 2002

☒ This action is **FINAL.**

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle,* 1935 C.D. 1 1; 453 O.G. 213.

Disposition of Claims

☒ Claim(s) 25-26, 33-46 AND 48-54 is/are pending in the application.

Of the above claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 25-26, 33-46 AND 48-54 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claim(s) _____ are subject to restriction or election requirement

Application Papers

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Pri rity under 35 U.S.C. § 119 (a)–(d)

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119 (a)–(d).

☐ All ☐ Some* ☐ None of the:

☐ Certified copies of the priority documents have been received.

☐ Certified copies of the priority documents have been received in Application No. _____.

☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a))

*Certified copies not received: _____.

Attachment(s)

☒ Information Disclosure Stat ment(s), PTO–1449, Paper No(s). 40,42,43

☐ Intervi w Summary, PTO–413

☐ Notice of Reference(s) Cited, PTO–892

☐ Notice of Informal Pat nt Application, PTO–152

☐ Notice of Draftsperson's Patent Drawing Revi w, PTO–948

☐ Other _____

Office Action Summary

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

2. Claims 53-54 are rejected under 35 U.S.C. 103(a) as being unpatentable over Faust et al. (3,978,258). Faust et al. disclose the basic claimed method of making a surface covering including providing first and second layers and mechanically embossing a portion of the second layer, wherein the second layer is a wear layer that has been cured prior to the mechanical embossing (column 5, lines 29-34). Based on the disclosure in Faust et al. at column 4, lines 35-42 of using other prior art techniques including use of inks containing blowing suppressants or inhibitors, it would have been obvious to one of ordinary skill in the art to practice chemical embossing in applying the method of Faust et al. in order to produce a product having a unique appearance. Since Faust et al. teach the aspect of applying a single wear layer composition, it is submitted that such composition is uniform in melt viscosity, as in claim 53.

3. Claims 25-26, 33-46 and 51-52 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shortway et al. (4,214, 028) as set forth in the previous Office action.

4. Claims 48-50 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shortway et al. as applied to claims 25-26, 33-46 and 51-52 above, and further in view of McCann et al. (4,100,318) as set forth in the previous Office action.

5. Applicants' arguments filed April 10, 2002 have been fully considered but they are not persuasive. Applicants disagree with the examiner's assertion that "forming embossed layers having such relative embossment depths would have been obvious ... to form a surface area covering having a cross section like that illustrated in Shortway et al. in Fig. 11" because Shortway is directed to a technique that is fundamentally different than that of the claimed method. This is not persuasive because in making the statement alluded to above, the examiner was addressing relative depth limitations present in applicants' instant claims and it is submitted again that the depth of the texturing illustrated in Fig. 11 of Shortway et al. is significantly less than the relatively large bumps produced by chemical embossing.

Applicants also argue that in Shortway, the entire surface of the wear layer is mechanically embossed and then a heating step follows with selective melting which converts a uniformly embossed wear layer into discrete embossed portion. But the scope of applicants' claims is such that they are readable on such a procedure.

Applicants also argue that Fig. 11 in no way comports to the clear and particular teachings required by the Federal Circuit to support a rejection under section 103 and argue that the examiner's statements are conclusory and not based on objective evidence of record. This examiner disagrees as it is the examiner's position that Shortway et al. provide such evidence.

Applicants also argue that the examiner has not provided requisite motivation to make the allegedly obvious modification to Shortway; this is not persuasive because the reference itself contains illustration which suggests an embodiment upon which applicants' claims are readable.

Concerning, McCann, applicants argue that the reversal of the order of the steps described in Shortway would result in the destruction of the intended operation of Shortway as the initial mechanical embossing step in Shortway leads to the use of components which will not be affected by a subsequent chemical embossing step. This is not persuasive because the scope of the claims at issue is such that it encompasses use of components which may or may not be affected by the timing of the chemical embossing step.

Applicants also argue that McCann expressly teaches chemical embossing as an alternative to mechanical embossing. But this is in reference to a prior patent to Nairn. Both the examiner and applicants have referenced the teachings of McCann at column 4, lines 8-15. The examiner is interpreting the textured foam resulting from passing the composite through a fusion and expansion oven as a form of chemical embossing and it appears that applicants are viewing this step as something other than chemical embossing.

Applicants also state that there are many chemical variables and mechanical variables which are important in the practice of the process at issue and that the examiner has not addressed these factors. But the examiner has addressed the limitations of the instantly claimed process.

6. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL.** See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Allan Kuhns whose telephone number is (703) 308-3462. The examiner can normally be reached on Monday to Thursday from 7:00 to 5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jan Silbaugh, can be reached on (703) 308-3829. The fax phone number for the organization where this application or proceeding is assigned is (703) 305-7718.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

Allan R. Kuhns

ALLAN R. KUHNS
PRIMARY EXAMINER AU 1732

6-17-02